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Docket No. 00-8012  
Application Serial No. 09/652,908

REMARKS

This amendment is responsive to the final Office Action<sup>1</sup> having a mail date of August 1, 2005. Claims 1-29 and 31 were presented for examination and were rejected. Claims 1, 9, 10, 18, 22, 26 and 29 are independent claims. Claims 1, 6, 9, 10, 15, 18, 22, 26 and 29 are amended. No new matter is added. Claim 31 is canceled without prejudice or disclaimer. Claims 1-29 are pending.

Preliminarily, Applicants note that on the final Office Action Summary sheet it indicates that the final Office Action is responsive to communications filed on August 31, 2000 (application filing date) and June 30, 2004. Applicants filed the prior amendment in this application responsive to the February 3, 2004 Office Action on May 3, 2004 and are not aware of a communication filed on June 30, 2004. Applicants respectfully request clarification in this regard.

Further, on page 2 of the final Office Action, paragraph #1, a new title is requested. Applicants note that this same request was previously made in the February 3, 2004 Office Action and, in response thereto, a new title was proposed in the amendment filed on May 3, 2004. The proposed title is: "SYSTEMS AND METHODS FOR PROVIDING IN-BAND AND OUT-OF-BAND MESSAGE PROCESSING", and is used on the first page hereof. Applicants, therefore, respectfully request that the Examiner withdraw the requirement for a new title. If this

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<sup>1</sup> The Office Action may contain a number of statements characterizing the cited reference(s) and/or the claims which Applicants may not expressly identify herein. Regardless of whether or not any such statement is identified herein, Applicants do not automatically subscribe to, or acquiesce in, any such statement. Further, silence with regard to rejection of a dependent claim, when such claim depends, directly or indirectly, from an independent claim which Applicants deem allowable for reasons provided herein, is not acquiescence to such rejection of that dependent claim, but is recognition by Applicants that such previously lodged rejection is moot based on remarks and/or amendments presented herein relative to that independent claim.

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proposed new title remains unacceptable to the Examiner, Applicants respectfully request that the Examiner suggest a different title which he prefers.

Claims 1-7, 9-16, 18-22 and 25-30 are rejected under 35 U.S.C. § 102(e) as being anticipated by Birrell et al. (U.S. Patent No. 6,185,551, hereinafter "Birrell"). Claims 8, 17, 23 and 24 are rejected under 35 U.S.C. § 103(a) as unpatentable over Birrell in view of Maurille (U.S. Patent No. 6,484,196, hereinafter "Maurille"). Claim 31 is rejected under 35 U.S.C. § 102(e) as being anticipated by Walters et al. (U.S. Patent Application Publication No. 2001/0052019, hereinafter "Walters"). Applicants respectfully traverse the Examiner's rejections under 35 U.S.C. §§ 102 and 103 with regard to the claims as now amended.

At pages 2-6 of the Office Action, the Examiner rejected pending claims 1-7, 9-16, 18-22, and 25-30 under 35 U.S.C. § 102(e) as allegedly anticipated by Birrell. Applicants respectfully traverse the rejection.

Consider, for example independent claim 1.

A personal messaging agent, comprising: a user profile configured to store user preferences for processing messages; a message filter configured to receive a message, perform in-band processing on the message based on the user preferences, and generate at least one event for triggering out-of-band processing of the message based on the user preferences before receiving the message in one or more mailboxes of the user; and at least one external helper configured to perform the out-of-band processing of the messages in response to the at least one event.

It is clear that claim 1 calls for, interalia, a message filter to generate an event for triggering out-of-band processing of the message based on user preferences and before receiving the message in a user mailbox. Birrell does not disclose or suggest this claim limitation for the following reasons.

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On page 2 of the final Office Action, paragraph 5, it says that Birrell discloses a message filter configured, interalia, to:

“perform in band processing (i.e., parsing) on the message, (See column 7 Lines 23-55) based on the user preferences (i.e., user defined labels), (See Column 8 Lines 42-48) and generate at least one event (i.e. outputting, displaying, or printing), (See Column 9 Lines 25-40), for triggering out of band processing, (i.e., removing the unread label) of the message, (See Column 9 Lines 25-40).”

It is clear from the above quoted section and from other places in the final Office Action that it takes the position that:

- Birrell’s user defined labels are equivalent to Applicants’ claimed user preferences.
- Birrell’s outputting a message such as displaying or printing that message is equivalent to Applicants’ claimed generating of an event.
- Birrell’s removing the unread label from the message is equivalent to Applicants’ triggering out-of-band processing.

Applicants do not agree with the position taken in the final Office Action, for reasons to follow below. Nevertheless, these sections of Burrill do disclose that users can define a set of labels and that outputting removes a label from the message:

Users can define a set of labels with which to work. The labels are nothing more than predefined text strings. The currently active set of labels for a particular user, e.g., the label state 330 of Fig. 3, is maintained by the account manager 300 and is displayed in a window of the graphical user interface. Labels can be added and removed by the system or by users. (Birrell, Col. 8, lines 42-48, Emphasis added.)

Outputting, e.g., displaying or printing, a message removes the unread label 720 under the assumption that it has been read. A user can explicitly add or remove the unread label. A message can be deleted by attaching a "delete" label 730. This has the effect that the message will not be seen again because messages labeled

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as deleted are normally excluded during searches. Removing the deleted label has the effect of "un-deleting" a message.

Although a preferred embodiment uses labels for data records that are mail messages, it should be understood that "mutable" labels can also be used for other types of data records. For example, labels which can be added and removed can be used with data records such as Web-pages, or news group notes. The key feature here being that labels are indexed in the same index as the record which they label, and that labels can be added and removed. (Burrill, col. 9, lines 25-40, Emphasis added.)

However, the final Office Action is overlooking a very important language recitation in this claim which had been earlier presented by way of the previous May 3, 2004 amendment. This important language recitation renders this mapping of Burrill against Applicants' claim limitation ineffective and irrelevant.

Applicants are reciting, interalia, a message filter to: "generate at least one event for triggering out-of-band processing of the message based on the user preferences before receiving the message in one or more mailboxes of the user." (Emphasis added.) Since, as pinpointed above, the final Office Action equates Birrell's user defined labels with Applicants' user preferences<sup>2</sup>, it logically follows that the content of any such label would necessarily reflect the user preference with respect to that label. This ultimately leads Applicants to the conclusion that Birrell is inapplicable to Applicants' claim 1. Indeed, according to the final Office Action, the only alleged out-of-band processing in Birrell that is being asserted is to remove the unread label upon outputting (printing, etc.). However, since these labels, allegedly reflecting user preference, can presumably contain virtually any purported preference message that the user

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cares to inject, the labels cannot be in alignment with the only out-of-band processing activity disclosed in Birrell,

unless each and every label's content is "delete the unread label" and indicates nothing else.

This, obviously, is an absurdity which results from a distorted view of the teachings of Birrell.

Indeed, Birrell does disclose "user preferences 370" in its Fig. 3 and related text, which are distinct from labels in Birrell. At first blush, it would seem that "user preferences 370" would be a better choice than "labels" to apply against Applicants' user preferences, merely based on the same terminology. But, the final Office Action chooses not to characterize user preferences 370 as being equivalent to Applicants' user preferences. Rather, the final Office Action favors the more strained interpretation of labels as being equivalent to Applicant's user preferences. Regardless, even if "user preferences 370" were chosen instead, they are also irrelevant to Applicants' claims.

With further reference to this issue of labels versus user preference, the final Office Action concludes that Birrell's outputting a message such as displaying or printing that message is equivalent to Applicants' claimed generating an event. But, the automatic result of outputting an unread message in Birrell is to necessarily remove an "unread" label attached to that message and that removal action is not based on the content of that label (the alleged user preference), in contradiction to the language of Applicants' claim 1. This is clear from the fact that labels of all unread messages are removed as a result of outputting those messages to which they are attached, regardless of each label's contents.

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<sup>2</sup> Notably, Birrell discloses "user preferences 370" separate from "label state 330" at least in Fig. 3 and related text. Nevertheless, user preferences 370 are not relied upon in the final Office Action in an attempted mapping to

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The Examiner relies upon removal of the unread label as allegedly being evidence of Applicants' triggering out-of-band processing. The problem for the Examiner with this reasoning is that Applicants' claim language requires its out-of-band processing to be based on user preferences. Since the Examiner has constrained Birrell's labels to contain the equivalent of Applicants' user preferences and since the only out-of-band processing in Birrell is removal of the "unread" label, then the only label that could meet this constraint would be a label with the absurd contents: "remove the unread label." All other valid and appropriate labels of varied content and scope in Birrell would not conform to this constraint<sup>3</sup>. Clearly, Birrell is deficient and its applicability to claim 1 fails. Therefore, it is respectfully submitted that Birrell does not disclose or suggest "a message filter configured to receive a message, perform in-band processing on the message based on the user preferences, and generate at least one event for triggering out-of-band processing of the message based on the user preferences before receiving the message in one or more mailboxes of the user" as recited in claim 1. A proper rejection under 35 U.S.C. § 102 requires that a single reference teach every aspect of the claimed invention either expressly or impliedly. Any feature not directly taught must be inherently present. In other words, the identical invention must be shown in as complete detail as contained in the claim. See M.P.E.P. § 2131. For this reason alone, it is respectfully submitted that the 35 U.S.C. §102(e) rejection of claim 1 be withdrawn and the claim allowed.

Moreover, Applicants have amended the message filter of claim 1 to be configured to generate an event for triggering out-of-band processing of the message based on user preferences

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Applicants' user preferences recited in claim 1, and understandably so.

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"before receiving the message in one or more mailboxes of the user." The support for this amendment is shown in Fig. 2, for example, and in related discussion in the specification, where a message from the E-mail sender arrives at PMA 220 well prior to being received in user mailboxes 120. The final Office Action suggested/encouraged this amendment, for example, on page 13, paragraph 44 and it, therefore, should be entered under 37 C.F.R. §1.116. This added language completely avoids any notion of the user generating an event, such as, e.g., printing, for triggering out-of-band processing of the message based on user preferences, because it is clear that the out-of-band processing of the message in amended claim 1 is conducted prior to delivery of the message to the user mailboxes and therefore prior to access by the user to the message.

Moreover, although Burrill's system can remove labels, (col. 8, lines 47-48) the system cannot remove an "unread" label prior to its message being received in a mailbox of the user because the message cannot be read by the user (where reading the message would legitimize removal of the "unread" label) until after it is received in the mailbox. Since removing "unread" labels is the alleged equivalent of Applicants' out-of-band triggering according to the final Office Action, Burrill's system also cannot satisfy this out-of-band triggering activity.

In view of the above analysis, it is clear that the final Office Action's mapping of Birrell to claim 1 is without merit. Therefore, for this additional reason, it is respectfully submitted that Birrell does not disclose or suggest "a message filter configured to receive a message, perform in-band processing on the message based on the user preferences, and generate at least one event for triggering out-of-band processing of the message based on the user preferences before

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<sup>3</sup> This may be somewhat analogous to the proverbial broken clock which is stopped and which gives correct time for an instant twice per day, but completely fails to be of any service for the remainder of the 24 hour period.

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receiving the message in one or more mailboxes of the user” as recited in claim 1. As noted, a proper rejection under 35 U.S.C. § 102 requires that a single reference teach every aspect of the claimed invention either expressly or impliedly. Any feature not directly taught must be inherently present. In other words, the identical invention must be shown in as complete detail as contained in the claim. See M.P.E.P. § 2131. For this additional reason, it is respectfully submitted that the 35 U.S.C. §102(e) rejection of claim 1 be withdrawn and the claim allowed.

The other references, Maurille and Walters do not cure this deficiency in teaching reference Birrell.

Independent claims 9, 10, 18, 22, 26, and 29 were each rejected on page 2, paragraph 5 of the final Office Action, for the same reasons presented above with respect to claim 1. Each of these other independent claims were amended to contain equivalent limitations to those discussed above with respect to claim 1 and are allowable for the reasons given with respect to claim 1.

Claim 9 recites, interalia: “means for generating at least one event for triggering out-of-band processing of the processed message based on the user preferences before receiving the message in a mailbox of the user.” (Emphasis added.)

Claim 10 recites, interalia: “before receiving the message stream in one or more mailboxes of the message recipient, generating at least one event for triggering out-of-band processing of the processed message stream based on the one or more preferences of the message recipient.” (Emphasis added.)

Claim 18 recites, interalia: “instructions for generating at least one event for triggering out-of-band processing of the processed message before receiving the message in a mailbox of



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the message recipient, the generating based on the one or more personal preferences of the message recipient." (Emphasis added.)

Claim 22 recites, interalia: "a plurality of personal messaging agents configured to receive the message streams from the server, perform in-band and out-of-band processing of the message streams before receiving the message streams in one or more mailboxes of the message recipients, the processing based on preferences of the one or more message recipients to create enhanced message streams, and output the enhanced message streams." (Emphasis added.)

Claim 26 recites, interalia: "a personal messaging agent configured to receive the e-mail message from the server, perform in-band and out-of-band processing on the e-mail message before receiving the e-mail message in one or more mailboxes of the e-mail recipients, the processing based on preferences of the one or more e-mail recipients to create a processed e-mail message, and output the processed e-mail message." (Emphasis added.)

Claim 29 recites, interalia: "performing in-band and out-of-band processing on the e-mail message before receiving the e-mail message in one or more mailboxes of the e-mail recipient based on the e-mail processing preferences." (Emphasis added.)

Claims 2-8 are dependent from claim 1 and are allowable at least for reasons based on their dependency, directly or indirectly, from an allowable base claim. These dependent claims are also patentable on their own, for reasons expressed in the prior amendment, which shall not be repeated herein. Claim 6 was amended to improve form.

Claims 11-17 are dependent from claim 10 and are allowable at least for reasons based on their dependency, directly or indirectly, from an allowable base claim. These dependent claims

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are also patentable on their own, for reasons expressed in the prior amendment, which shall not be repeated herein. Claim 15 was amended to improve form.

Claims 19-21 are dependent from claim 18 and are allowable at least for reasons based on their dependency, directly or indirectly, from an allowable base claim. These dependent claims are also patentable on their own, for reasons expressed in the prior amendment, which shall not be repeated herein.

Claims 23-25 are dependent from claim 22 and are allowable at least for reasons based on their dependency, directly or indirectly, from an allowable base claim. These dependent claims are also patentable on their own, for reasons expressed in the prior amendment, which shall not be repeated herein.

Claims 27-28 are dependent from claim 26 and are allowable at least for reasons based on their dependency, directly or indirectly, from an allowable base claim. These dependent claims are also patentable on their own, for reasons expressed in the prior amendment, which shall not be repeated herein.

Claim 31 has been canceled without prejudice or disclaimer, thus mooting its rejection.

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**CONCLUSION**

In view of the foregoing amendments and remarks, Applicants respectfully request the reconsideration of this application and the timely allowance of the pending claims.

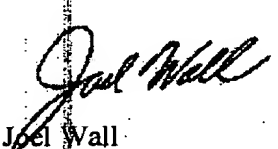
This amendment should be entered under Rule 116 because it merely cancels a claim, amends other claims per the Examiner's suggestion in the final Office Action, and does not require further searching or consideration.

To the extent necessary, a petition for an extension of time under 37 C.F.R. § 1.136 is hereby made.

Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account No. 07-2347 and please credit any excess fees to such deposit account.

Verizon Corporate Services Group Inc.

By:

  
Joel Wall  
Reg. No. 25,648

Date: September 30, 2005

600 Hidden Ridge, HQE03H14  
Irving, Texas 75038  
(972) 718-4800

Customer No. 32127

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